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BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON, DC 20001

EXAMINER

WEBB, JAMISUE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,082

Applicant(s)

BJERRE ET AL.

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,13-16 and 52-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,13-16 and 52-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8, 13-16, 52-77 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. With respect to Claims 1, 13, and 68: the phrase “exchange information providing a user interface displayed on a user computer” is indefinite. It is unclear to the examiner how an action (exchange of information) can provide something physical (a user interface).
4. With respect to Claims 58, 59, 62, 67, 70-72: The claims state a number of acronyms which were never defined in the claims themselves, therefore leaving them to be unclear. The examiner suggests writing out the terms EDI and XML where they first appear in the claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

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do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-8 and 13-16, 52-58, 60, 61, 65, 68, 69, 71, 73-75 and 77 are rejected under 35 U.S.C. 102(e) as being anticipated by Kluss (6,463,419).

7. With respect to Claims 1, 69, and 73: Kluss discloses the use of a common carrier system (See Figure 17) comprising:

- a. A first storage located at a first entity (Computer 30A, Figure 1);
- b. A second storage located at a second entity (Computer 30B, Figure 1);
- c. A server that receives information from the first and second storages (40);
 - i. The server has a user interface (Column 4, lines 34-55), which exchanges information with a user, enabling the user to create an electronic booking request, submit a booking request and receiving confirmation of the booking request (column 9, lines 23-29). Kluss discloses a charterer sending an e-mail to the ship owner to start negotiations, the examiner considers this to be a form of an electronic booking request. It is the examiner's position that the system of Kluss is fully capable of performing operations such as the user submitting request form a first entity, and receiving conformation from the first entity, due to the fact that the user and the entity enter into communication through e-mail, and are fully capable of sending messages back and forth to each other. Whether these

messages are negotiations or confirmation e-mails are merely non-functional descriptive material that are not functionally related to the system.

8. With respect to Claims 2-4: Kluss discloses the user interface can be customized by the user (column 7 line 42 to column 8 line 2 and column 14, lines 49-65). The system of Kluss uses customized contracts, and customized user interfaces, which the examiner considers these to be templates. The examiner considers the system of Kluss being fully capable of performing the steps of the system claim of the present invention, specifically where the “previously drafted electronic booking request” where it was selected from the results of a search performed by the user, or was a confirmed electronic booking request, due to the fact that the forms and user interfaces are customizable. These are method limitations in a system claim, Kluss discloses the claimed structural limitations, and is fully capable of creating customer interfaces or forms.
9. With respect to Claim 5: Kluss discloses the system being used for maritime freight operations enabling a container to be transported (see abstract).
10. With respect to Claims 6 and 7: Kluss discloses the charterer and the owner of the ship engaging in negotiations to determine the cost of shipping. The examiner considers Kluss to disclose entering two booking requests, one when the initial cargo parameters into the system (Step 1604), submitted before price negotiations (claim 7), and then negotiations occur, and the conclusion of the negotiations where the user enters into a contract (Step 1608) being a second booking request done after negotiations (claim 6). Kluss also discloses that after negotiations are concluded the price is held for the user for a later day, therefore price negotiated before booking request (column 15, lines 52-58).

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11. With respect to Claim 8: Kluss discloses a new user registering with the site (column 7, lines 1-17).

12. With respect to Claims 13 and 14: Kluss discloses the use of a system comprising a common carrier interface (See Figure 17, column 4, lines 34-55). The interface enabling a user to create a booking request, submit the booking request to an entity then receive confirmation from the entity (column 9, lines 23-29). Kluss discloses the generation of an event notification (column 26, lines 42-53) in the contract that is decided and entered into by both users, the charter and the owner of the ship (column 7, lines 47-67). It is the examiner's position that the system of Kluss is fully capable of performing operations such as the user receiving notification messages, due to the fact that the user and the entity enter into communication through e-mail, and are fully capable of sending messages back and forth to each other. Whether these messages are negotiations or notifications e-mails are merely non-functional descriptive material that are not functionally related to the system.

13. With respect to Claims 15 and 16: Kluss discloses the use of a notification of failure of delivery (non-even) or delay of delivery (column 26, line 42 to column 27 line 37).

14. With respect to Claims 52, 53, and 74: Kluss discloses the information such as loading and discharge ports (column 8, lines 13-24), which the examiner considers to be routing information.

15. With respect to Claim 54: Column 8, lines 13-24.

16. With respect to Claims 55-57: the system of Kluss discloses a user interface, which allows a user to send messages back and forth with the ship owner. However, the specific

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message is deemed to be nonfunctional descriptive material and is not functionally related to the system itself. The System of Kluss is fully capable of sending these types of messages.

17. With respect to Claims 61, 63, and 65: See Column 2, lines 8-13 and Claim 7.

18. With respect to Claims 58, 60, and 71: See Column 6, lines 19-28.

19. With respect to Claims 68: Kluss discloses the use of a common carrier system (See Figure 17) comprising:

- d. A first storage located at a first carrier (Computer 30A, Figure 1);
- e. A second storage located at a second carrier (Computer 30B, Figure 1);
- f. A server that receives information from the first and second storages (40);
 - ii. The server has a user interface (Column 4, lines 34-55), which exchanges information with a user, enabling the user to create an electronic booking request, submit a booking request and receiving confirmation of the booking request (column 9, lines 23-29). Kluss discloses a charterer is fully capable of being in communication with multiple ship owners (carriers) (See Figure 1), to start negotiations, the examiner considers this to be a form of an electronic booking request. It is the examiner's position that the system of Kluss is fully capable of performing operations such as submitting a routing request, submitting shipping instructions, receiving confirmation from the carriers, receiving routing information from the carriers and receiving booking activity plans from the carriers, due to the fact that the user and the carriers enter into communication through e-mail, and are fully capable of sending messages back and forth to each other. Whether these messages are negotiations or confirmation e-mails are

merely non-functional descriptive material that are not functionally related to the system.

20. With respect to Claim 75: Kluss discloses the user and the carrier entering into a contract, and does not specifically disclose the request comprising a carrier booking number. However, the specific type of information that is contained in the request, such as the carrier booking number, is deemed to be nonfunctional descriptive material and is not functionally involved in the system or the steps recited. The system being capable of sending a booking request would be performed the same regardless of what type of information is on the request. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

21. With respect to Claim 77: Kluss discloses the use of a system that is configured to store and keep track of contracts (booking requests). The system of Kluss allows a user to modify contracts, therefore it is the examiner's position that the system of Kluss is fully capable of allowing a user to modify a booking request after a container has been moved.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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23. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

24. Claims 59, 62, 64, 66, 67, 70 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kluss.

25. As disclosed above for Claims 1 and 68, Kluss discloses the use of electronic communication, but does not disclose expressly that the information is in EDI format, or by the use of a pop-up dialogue box. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the booking request of Kluss be in the form of an EDI or pop-up dialogue because Applicant has not disclosed the having the communication be either EDI or a pop-up dialogue box, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any form of electronic communication because it results in a message (booking request) being sent over a network. Therefore it would have been an obvious matter of design choice to modify Kluss to obtain the invention as specified in Claims 59, 62, 64, 66, 67, 70 and 72.

26. Claim 76 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kluss in view of Guidice et al. (6,463,420).

27. With respect to Claim 76: Kluss discloses the use of a system that is used in the coordination of shipping. Kluss however, fails to disclose the system being able to track containers. Guidice discloses the use of a system that provides online tracking and delivery stations over the internet (see abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kluss, to include tracking and delivery status capability, as disclosed by Guidice, in order to increase the efficiency and convenience of tracking delivery status, and to provide information to a user. (See Guidice, Column 2)

Response to Arguments

28. Applicant's arguments filed 7/5/05 have been fully considered but they are not persuasive.

29. With respect to Applicant's arguments that Kluss does not disclose the system "creating an electronic booking request": Again as stated previously, the claims are directed to a system claim, which are limited to the structure of the system. Kluss discloses a system which uses a user interface, and the system is fully capable of creating a booking request. Kluss discloses the charter sending a message to the ship owner, the first message is considered to be a booking request.

30. With respect to Applicant's arguments that Kluss fails to disclose receiving a confirmation of the electronic booking request: Kluss discloses the charterer and ship owner negotiating back and forth by e-mail until an agreement is entered into. The e-mail that the ship

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owner sends back to the charterer and the final agreement, the examiner considers to be a confirmation of the electronic booking request.

31. With respect to Applicant's arguments that Kluss does not disclose forms that have been previously drafted by the user, or another user: As mentioned earlier, this claim is drawn to a system, the system contains forms that are used to create contracts, who the forms were created by is non-functional limitations of the system claim. Kluss discloses that the standard forms and interfaces can be customized by the user, and a database can store these preferences, therefore the examiner considers this to be that the booking request and confirmation are drafted from previously requests.

32. With respect to Applicant's argument that Kluss does not discloses the use of search results from which a previously drafted electronic booking may be selected: This limitation is a method limitation, in a system claim. The system of Kluss is fully capable of performing searches, as is any system with a database; therefore it is the examiner's position that the system of Kluss is fully capable of forming this method step.

33. For the reasons stated above, the examiner considers Kluss to disclose the claimed invention, therefore the rejections stand as stated above.

34. In the personal interview on 7/11/05: It was suggested that in order to put the claims in better form for allowance that the applicant first specify in the claims that the storage of the first and second entity are data storages. It was also suggested that the applicant focus the claims on how the system coordinates the shipping from the starting to the final destination, and coordinating the timing of the "hand off" in the middle point. It was suggested that the claims

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are drawn to the system coordinating with both entities to coordinate the entire shipping between the starting point, through the middle point and to the final destination.

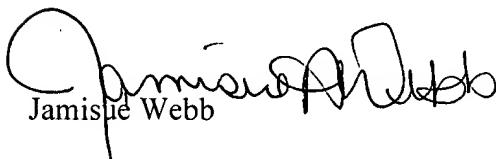
Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811.

The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamisue Webb


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600